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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,462	09/18/2000	Paul R. Mathewson	0313.MATH.CN1	4305

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EXAMINER

WIEKER, AMANDA FLYNN

ART UNIT PAPER NUMBER

3743

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/664,462

Applicant(s)

MATHEWSON, PAUL R.

Examiner

Amanda F. Wieker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-17 is/are allowed.
- 6) ☒ Claim(s) 1,2 and 18-22 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed on 23 February 2004 has been made of record in the application. Claims 1-2 and 4-22 are pending. Claims 1-2, 4 and 18-20 have been amended. New claim 22 has been added.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT Publication WO 94/00082 to Paterson in view of Patent Publication DE 4,013,693 to Eisenberg.

Paterson discloses an orthopedic brace (see Figures) providing active resistance to axial rotation and translation in a joint (page 2, lines 22-24) comprising at least one circumferentially spiraling, longitudinally inelastic bracing member (7/8) having a proximal terminal end positioned on one side of a joint (at 9), a distal terminal end positioned on the other side of the joint (at 6) along a longitudinal axis formed through the joint and a circumferentially spiraling distance extending between said proximal terminal end and said distal terminal end defining a circumference oriented about the joint from said proximal terminal end to said distal terminal end (see Figures 4 and 6, specifically), wherein active resistance to axial rotation and translation of the joint is necessarily provided by a change in said circumference responsive to a change in the position of said proximal terminal end relative to said distal terminal end. The brace further

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comprises a bracing member support (cuffs 1a and 5), said proximal terminal end and said distal terminal end being attached to said bracing member support. Paterson discloses an orthopedic brace for actively resisting axial rotation and translation in a joint comprising: a first bracing member support (1a) positioned on one side of a joint; a second bracing member support (5) positioned on the other side of the joint and spaced from said first bracing member support along a longitudinal axis formed through the joint; at least one circumferentially spiraling bracing member (7/8) having a first terminal end (at 9) structured for attachment to said first bracing member support (1a) and a second terminal end (at 6) structured for attachment (i.e., integrally sewn with) to said second bracing member support (5), said first terminal end having a securement structure (hook and eye) connected thereto, which necessarily maximizes lateral vector forces acting on said first terminal end. The second terminal end also has a securement structure (integrally sewn) connected thereto, which necessarily maximizes lateral vector forces acting on said second terminal end. (Paterson necessarily performs this function because both Applicant's invention and Paterson's device provide active resistance to axial rotation and translation in a joint by attachment of spiraling bracing member to two supports, located on both sides of the joint. This necessarily produces a "lateral vector force"). The spiraling bracing member is of a length to spiral unidirectionally from one side of the joint to the other side. Paterson does not specify that the spiraling bracing member be length-adjustable.

Eisenberg discloses an orthopedic brace for providing active resistance to axial rotation and translation in a joint comprising at least one circumferentially spiraling, longitudinally inelastic bracing member. The bracing member is length-adjustable to allow adjustment of the bracing member to accurately fit the desired user.

It would have been obvious to one skilled in the art at the time the invention was made to have provided the orthopedic brace disclosed by Paterson, wherein the spiraling bracing member is length-adjustable, as taught by Eisenberg, to allow adjustment of the bracing member to fit the user. The claimed method of using the device is made obvious by the normal use of the device disclosed by Paterson with a length-adjustable spiraling bracing member, as taught by Eisenberg.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 22 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,142,965 in view of Eisenberg.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of '965 discloses at least an orthopedic brace providing active resistance to axial rotation and translation in a joint comprising at least one circumferentially spiraling bracing member, having a proximal end positioned on one side of a joint, a distal end positioned on the other side of the joint along a longitudinal axis formed through the joint and a circumferentially spiraling distance extending between said proximal end and said distal end defining a circumference oriented about the joint from said proximal end to said distal end, said at least one circumferentially spiraling bracing member being sized in length to spiral unidirectionally from one side of the joint to the other side of the joint, and active resistance to axial rotation and translation of the joint being provided by a change in said circumference responsive to a change in the position of said proximal end relative to said distal end of said circumferentially spiraling bracing member. Claim 1 does not specify that the bracing member be length-adjustable or longitudinally inelastic.

Eisenberg discloses an orthopedic brace for providing active resistance to axial rotation and translation in a joint comprising at least one circumferentially spiraling, longitudinally inelastic, length-adjustable bracing member, to allow adjustment of the bracing member to accurately fit the desired user.

It would have been obvious to one skilled in the art at the time the invention was made to have provided the orthopedic brace disclosed by '965, wherein the spiraling bracing member

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is inelastic and length-adjustable, as taught by Eisenberg, to allow adjustment of the bracing member to fit the user.

Allowable Subject Matter

6. Claims 5-17 are allowed.
7. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. The indicated allowability of claim 21 is withdrawn in view of the newly discovered reference(s) to Paterson. Because claim 21 was indicated allowable, but is now being rejected, this action is NON-FINAL.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda F. Wieker whose telephone number is 571-272-4794. The examiner can normally be reached on Monday-Thursday, 7:30 - 5:00 and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Amanda F. Wieker
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